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In re application of
Hisato Shinohara et al
Serial No. 07/169,127
Filed: December 20, 1993
For: METHOD AND SYSTEM OF LASER
PROCESSING

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DECISION ON
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PETITION
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This is a decision on the PETITION FOR REVIEW OF EXAMINER'S REFUSAL TO ENTER REPLY BRIEF, filed December 10, 1996 and accepted as a petition under 37 CFR 1.181(no fee). The petitioner requests entry of the REPLY BRIEF of July 2, 1996, which was refused entry in the Letter of October 8, 1996 since the discussion "on the contents of the 'summary of the Invention' pertain to no grounds of rejection or any argument contained therein, hence or [sic] not a new issue." Petitioner asserts that the discussion of the invention in the Summary of the Invention at section V. of the BRIEF FOR APPELLANT was not raised for the first time in the application prosecution. The petitioner further asserts that the examiner's allegations regarding the propriety of the Summary of the Invention were raised for the first time in the Examiner's Answer, and therefore the appellants are permitted to respond, see 37 CFR 1.193(b).

DECISION

A thorough review of the entire application record indicates that the examiner's refusal to enter the REPLY BRIEF of July 2, 1996 as not being limited to new points of argument raised in the examiner's answer was inappropriate. Specifically, the appellant's AMENDMENT AFTER FINAL of August 24, 1995, at page 4, states that the:

"252 priority application discloses all the claimed subject matter of the present application...including emitting a rectangular laser beam, expanding the beam in a first direction, removing a portion of the beam through a mask wherein the portion includes edges of the expanded beam, and condensing the beam in a second direction orthogonal to the first direction to form a line shaped laser beam."

Additionally, claim 1 as originally filed states:

"A method for treating an object with a laser comprising the steps of:
emitting a laser beam from a laser;
expanding said laser beam in a first direction;

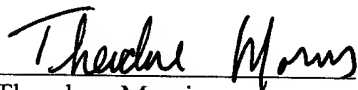
removing a portion of said laser beam though [sic] a mask, said portion including at least edges of said expanded laser beam extending in said first direction; and
condensing said laser beam in a second direction orthogonal to said first direction in order to form a line-shaped laser beam on an object.”

Each of these passages is consistent with the discussion of the methodology of the invention in the Summary of the Invention at section V of the BRIEF FOR APPELLANT. Therefore, the examiner's contention that said discussion of the invention is “deficient” and is therefore a “new issue” at section (5) of the Examiner's Answer does constitute a new point of argument in the examiner's answer which would permit the appellants to respond with a reply brief pursuant to 37 CFR 1.193(b). Additionally, a review of the REPLY BRIEF reveals only a discussion of the examiner's contention regarding the alleged deficiencies in the section V of the BRIEF FOR APPELLANT. Therefore, the REPLY BRIEF should have been entered.

The application shall be returned to the examiner for prompt consideration of the REPLY BRIEF and preparation of an appropriate office action.

It is further noted that the instant petition was accompanied by \$130.00 as a petition fee. However, a petition of this type does not require a \$130.00 petition fee. Therefore, a refund of the \$130.00 may be obtained by directing a copy of this decision along with a written request for such a refund to the Office of Finance.

The Petition is GRANTED.



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